

III. REMARKS

1. Claims 24 and 30 are amended. Claim 29 is cancelled without prejudice.

2. It is respectfully submitted that claims 8-14 are not anticipated by New et al. ("New") U.S. Patent No. 6,471,979 under 35 U.S.C. §102(e), because New is not a proper reference against Applicant's invention for purpose of 35 U.S.C. §102(b). Applicant's priority date precedes the filing date of New for the subject matter that is being cited against Applicant's invention.

New is a Continuation-In-Part ("CIP") application. The effective filing date for subject matter not supported by the parent application, or that is new to the CIP application, is the filing date of the CIP application (M.P.E.P. §§ 2133.01, 2136.02, 1895 and 1896). The filing date of the CIP is August 30, 2001. Applicant's effective priority date is April 20, 2001, which is prior to the actual filing date of New. Thus, while subject matter disclosed in the parent application for New may be entitled to an effective filing date that precedes Applicant's filing date, the additional subject matter in New that was not present in the parent application, is only entitled to an effective filing date of August 30, 2001.

Applicant's invention according to claim 8 recites "applying 17beta-estradiol to said stent body." This feature is not disclosed in parent application for New, PCT/US00/35641. Rather, the use of "17beta-estradiol" is new or additional subject matter first disclosed in New (the CIP) and is only entitled to an effective filing date of August 30, 2001.

A close examination of the priority application of New, PCT/US00/35641, filed on December 29, 2000, reveals that at least the subject matter beginning in Col. 7, line 16 of New was not present in the parent application, PCT/US00/35641. Rather, the portions of the specification of New beginning in Col. 7, line 16 is additional or "new matter", and is not entitled to the effective filing date of the priority, or parent application.

The first disclosure in New of "17B-estadiol" stents appears in Col. 7, lines 17-18 of New. For the reasons noted above, this portion of New is only entitled to the effective filing date of August 30, 2001, which is after Applicant's filing date of April 20, 2001. Therefore, New, as applied to claims 8-14, is not effective prior art for purposes of 35 U.S.C. §102(b).

3. Claims 15-31 are not unpatentable over New under 35 U.S.C. §103(a).

Claims 15-23 depend from claim 8, which as discussed above, is not an effective prior art reference, since the date of disclosure in New is subsequent to Applicant's filing date.


Claim 24 is amended to recite that the coating substance contains 17beta-estradiol. Thus, for the same reasons discussed above, claim 24, and claims 25-31, which depend therefrom are not unpatentable over New. Claim 30 is amended to correct the claim dependency.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should

any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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30 April 2004
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